

Appl. No. 09/384,811
Amdt. dated July 14, 2004
Reply to Office Action of June 16, 2004

PATENT

REMARKS/ARGUMENTS

Applicants acknowledge with appreciation the time taken by Examiners Collins and Nelson to discuss the present application in the interview on June 30, 2004 and the telephone interview on July 8, 2004. Applicants believe significant progress was made towards putting the claims in condition for allowance as explained in more detail below.

Rejection under 35 U.S.C. §112, first paragraph

In the Office Action, the Examiner has rejected claims 9, 11, and 26 for allegedly lacking enablement because the claims do not explicitly recite introducing a nucleic acid encoding an Ac transposase into the barley plants. Applicants note that claim 12, which explicitly recites this step, is not included in the rejection. As discussed during the telephone interview, this rejection can be overcome by including the limitations of claim 12 in claim 9. As also discussed during the interview, the amendment to claim 9 explicitly states that the step of introducing the nucleic acid encoding the Ac transposase can occur before or after the step of introducing the Ds element comprising the transgene. Finally, as further discussed, the claims have been simplified to remove reference to barley plant populations. No new matter is introduced by these amendments. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(a)

The rejection of the claims for allegedly being obvious over the prior art of record is respectfully traversed. Applicants note from the Office Action that, based on the evidence of record, the Examiner appreciates that the methods of the invention are surprisingly effective in producing stably transformed barley plants. During the interviews, applicants understood the Examiner to confirm this. The primary issue appears to be a question of whether the claims sufficiently recite the advantages of the claimed methods.

As explained during both interviews, the preamble of the claims states that methods of the invention produce stably transformed barley plants comprising a stably expressed transgene. The claims then state the methods steps that produce such plants. As noted above, the Examiner apparently accepts that the claimed methods are surprisingly effective in generating such plants compared to prior art methods. It is well settled that the advantages of a

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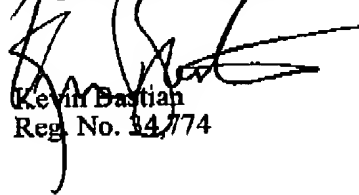
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claimed invention need not be explicitly disclosed in the specification (*see e.g.*, MPEP §716.02(f)). Thus, applicants respectfully submit that the claims need not explicitly recite the unexpected advantages of the claimed methods to distinguish the invention from the prior art. In view of the above, applicants believe the rejection is improper and should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,



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